

III. REMARKS

Claims 1-20 are pending in this application. By this amendment, claims 1, 2, 10, 12 and 17 have been amended. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, claims 12-16 and 17-20 are rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Claims 12, 14, 16-17 and 19 are rejected under 35 U.S.C. §102(a) as allegedly being anticipated by Ohsugi *et al.*, ‘A Recommendation System for Software Function Discovery’ APSEC 2002, pages 248-257, hereafter “Ohsugi.” Claims 1-11, 13, 15, 18 and 20 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Ohsugi in view of Arcuri *et al.* (U.S. Patent No. 6,121,968), hereafter “Arcuri.”

A. REJECTION OF CLAIMS 12-16 AND 17-20 UNDER 35 U.S.C. §101

The Office has rejected claims 12-16 and 17-20 for allegedly being directed to non-statutory subject matter. Specifically, with regard to independent claim 12, the Office asserts that the claimed system would reasonably be interpreted by one of ordinary skill in the art as software, per se. Applicant respectfully traverses the rejection and submits that Applicant’s original specification specifically states that “the present invention can be realized in hardware, software, or a combination of hardware and software. Accordingly, Applicant respectfully

submits that the Office's assumption that the claimed system is software, per se, is not supported, whether or not it is pertinent.

The Office further objects to the use of the limitation "a recordable medium" in claim 17. Applicant has amended claim 17 to recite, "a program product stored on a computer readable medium." Claims 18-20 depend from claim 17. Applicant asserts that this amendment further directs the invention to statutory subject matter. Accordingly, Applicant requests that the rejection be withdrawn.

B. REJECTION OF CLAIMS 12-16 AND 17-20 UNDER 35 U.S.C. §102(e)

With regard to the 35 U.S.C. §102(a) rejection over Oshugi, Applicant asserts that Oshugi does not teach each and every feature of the claimed invention. For example, with respect to independent claims 12 and 17, Applicant submits that Oshugi fails to teach calculating a use weight for the user interface element with respect to another user interface element based on the use counts for the group of users. The Office equates this feature of the claimed invention with the collaborative filtering procedure illustrated in FIG. 3 of Oshugi. However, Oshugi never teaches that this filtering procedure calculates a use weight for the interface element with respect to another user interface element. In contrast, the claimed invention includes "...calculating a use weight for the user interface element with respect to another user interface element based on the use counts for the group of users." Claim 12. As such, unlike the collaborative filtering procedure of Oshugi, the use weight of the claimed invention is calculated with respect to another user interface element. Thus, the collaborative filtering procedure of Oshugi does not

teach the calculating of the use weight of the claimed invention. Accordingly, Applicant respectfully requests that the Office withdraw its rejection.

With respect to dependent claims, Applicant herein incorporates the arguments presented above with respect to the independent claims from which the claims depend. Furthermore, Applicant submits that all dependant claims are allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicant respectfully requests withdrawal of this rejection.

C. REJECTION OF CLAIMS 1-11, 13, 15, 18 AND 20 UNDER 35 U.S.C. §103(a)

With regard to the 35 U.S.C. §103(a) rejection over Ohsugi in view of Arcuri, Applicant asserts that the combined references cited by the Office fail to teach or suggest each and every feature of the claimed invention. For example, with respect to independent claims 1 and 10, as argued herein with respect to independent claims 12 and 17, Applicant respectfully submits that Oshugi fails to teach "...calculating a use weight for the user interface element with respect to another user intereface element based on the use counts for the group of users." Acuri does not cure this deficiency. Accordinigly, Applicant respectfully requests that the rejection be withdrawn.

With respect to dependent claim 2, Applicant submits that the cited references fail to teach or suggest defining the group of users to include a plurality of users that use an application having the user interface element for a given job function. Neither Ohsugi nor Arcuri teaches or suggests a group of users that use a particular application for a given job function. Accordingly, Applicant respectfully requests that the Office withdraw its rejection.

With regard to the Office's other arguments regarding dependent claims, Applicant herein incorporates the arguments presented above with respect to independent claims listed above. In addition, Applicant submits that all dependant claims are allowable based on their own distinct features. However, for brevity, Applicant will forego addressing each of these rejections individually, but reserves the right to do so should it become necessary. Accordingly, Applicant respectfully requests that the Office withdraw its rejection.

IV. CONCLUSION

In addition to the above arguments, Applicant submits that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicant does not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicant does not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicant reserves the right to present such arguments in a later response should one be necessary.

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,



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Hunter E. Webb
Reg. No.: 54,593

Hoffman, Warnick & D'Alessandro LLC
75 State Street, 14th Floor
Albany, New York 12207
(518) 449-0044
(518) 449-0047 (fax)

RAD/hew